

OFFICIAL
05/05/2004

TOWNSEND
and
TOWNSEND
and
CREW
LLP

URGENT

Palo Alto, California
Tel 650 326-2400

Walnut Creek, California
Tel 925 472-6000

San Diego, California
Tel 650 350-6100

Denver, Colorado
Tel 303 571-4000

Seattle, Washington
Tel 206 467-9600

San Francisco

Two Embarcadero Center
Eighth Floor
San Francisco
California 94111-3834
Tel 415 576-0200
Fax 415 576-0300

FACSIMILE COVER SHEET

Date: May 05, 2004	Client & Matter Number: 022101-001800US	No. Pages (including this one): 24
To: Examiner Goldberg USPTO	At Fax Number: 571-273-0743	Confirmation Phone Number:
From: Kevin Bastian		(4698)

Message: Per your request, attached is a copy of David Gelfand's Declaration as filed on April 22, 2004.

Original With:	BE SENT BY MAIL	BE SENT BY FEDEX/OVERNIGHT COURIER	BE SENT BY MESSENGER	X	NOT BE SENT
---------------------------------	------------------------	---	-----------------------------	----------	--------------------

Faxed: Return to: Stephanie J. Whitehurst - (4576)

If you have problems with reception please call Fax Services at extension 4659

Important -

This message is intended only for the use of the individual or entity to which it is addressed and may contain information that is privileged, confidential, and/or exempt from disclosure by applicable law or court order. If the reader of this message is not the intended recipient, or the employee or agent responsible for delivering the message to the intended recipient, you are hereby notified that any dissemination, distribution, or copying of this communication is strictly prohibited. If you have received this communication in error, please notify us immediately by telephone and return the original message to us at the above address via the United States Postal Service. Thank you.

60209610 v1

TO THE U.S. PATENT AND TRADEMARK OFFICE

MAIL STOP: AF

Please stamp the date of receipt of the following document(s) and return this card to us:

INVENTOR(S):	SMITH
RE:	HIGH TEMPERATURE REVERSE TRANSCRIPTION USING MUTANT DNA POLYMERASES
TITLE OF DOCUMENT(S):	PTO/SB/21 Transmittal (1pg); PTO/SB/17 Transmittal (1pg) Amendment (24pp); Declaration Under 37 CFR 1.132 of David H. Gelfand (20pp); Certificate of First Class Mailing; Return Receipt Postcard
Application No.	09/823,649
File No.	022101-001800US
Date Due	April 22, 2004
Date Mailed	April 22, 2004
Attorney/Secretary	KLB/sjw

Please stamp the date of receipt of the enclosed documents and return this card to addressee

OFFICIAL

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

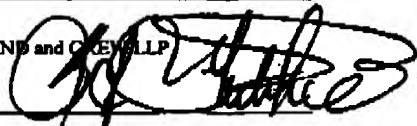
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PATENT
Attorney Docket No.: 022101-001800US
Client Ref. No.: 19052-US

On April 22, 2004

TOWNSEND and TOWNSEND and CREVELL LLP

By: Stephanie J. Whitehurst



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Smith et al.

Application No.: 09/823,649

Filed: March 30, 2001

For: HIGH TEMPERATURE REVERSE
TRANSCRIPTION USING MUTANT
DNA POLYMERASES

Customer No.: 20350

Confirmation No.

Examiner: Goldberg, J.

Technology Center/Art Unit: 1634

DECLARATION UNDER 37 CFR § 1.132
OF DAVID H. GELFAND

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

1. I, David H. Gelfand, Ph.D., am Vice President of Discovery Research and Director of the Program in Core Research at Roche Molecular Systems. I am a co-inventor of the subject matter of the above-referenced patent application.

2. I hold a Ph.D. from the University of California San Diego, which was conferred in 1970. I have published more than forty-five scientific papers and book chapters and have received more than forty-five U.S. issued patents, particularly in the area of PCR and thermostable DNA polymerases. A copy of my curriculum vitae is attached as Exhibit 6.

Appl. No. 09/823,649
Amdt. dated April 22, 2004
Reply to Office Action of October 22, 2003

PATENT

3. I have read and am familiar with the contents of the above-referenced patent application and claimed subject matter. It is my understanding that the Examiner has rejected the claims for allegedly lacking enablement. This declaration is provided to show that DNA polymerases that, in their native form, comprise the motif defined by SEQ ID NO: 1 could be identified with routine methods at the time of the invention. In addition, using the teachings of the specification, one of skill could readily make and test mutants of these proteins for reverse transcriptase activity.

4. The structural and functional properties of thermoactive DNA polymerases were well-known in 2000, the effective filing date of the present application. Because of their use in PCR amplification assays and for DNA sequencing, thermoactive DNA polymerases had been the subject of study for over fifteen years at the time the present application was filed. At the time of filing, dozens of eubacterial thermoactive or thermostable DNA polymerase enzymes had been identified. Indeed, many high-resolution crystal structures of DNA polymerases derived from thermophilic microorganisms have been published. *See Kim, Y., et al. 1995. Nature 376:612; Eom, S.H., et al. 1996. Nature 382:278; Kieffer, J.R., et al. 1997. Structure 5:95; Keifer, J.R. et al. 1998 Nature. 391:304; Li, Y. et al. 1998. EMBO J. 17:7514; Li, Y. et al. 1998. Prot. Sci. 7:1116; Hopfner, K-P., et al. 1999. Proc. Natl. Acad. Sci., USA. 96:3600.* Furthermore, a recent review of DNA Polymerase structure and fidelity (Beard, W.A. & Wilson, S.H. 2003. *Structure* 11:489) highlights the structural conservation of motif elements in diverse DNA polymerases.

5. Based on these high resolution crystal structures, the structural features of DNA polymerases derived from thermophilic microorganisms were well known. Without wishing to be bound by theory, we believe that position 4 of the claimed motif is important to the reverse transcriptase activity of the enzyme because mutations at position 4 are likely to result in "tighter binding" of said polymerase to primer-template substrate.

6. Based on these known structural features, using standard sequence alignment programs described, for example, at page 13, lines 18-28 of the present application, one of skill could readily identify candidate thermoactive DNA polymerases. If necessary, one of ordinary skill in the art could easily verify whether a particular enzyme has thermoactive DNA

Appl. No. 09/823,649
Amdt. dated April 22, 2004
Reply to Office Action of October 22, 2003

PATENT

polymerization activity using simple experiments well-known to the art. For example, the ordinarily skilled artisan could identify that an enzyme has DNA polymerization activity by performing a primer extension assay. The thermostability of the enzyme can easily be tested by heating the enzyme before the assay. Alternatively, the ordinarily-skilled artisan could simply refer to the extensive literature to identify a suitable candidate enzyme for use in the methods of the invention. For example, see Lawyer, F.C., Stoffel, S., Saiki, R.K., Myambo, K., Drummond, R., and Gelfand, D.H. (1989). Isolation, Characterization, and Expression in *Escherichia coli* of the DNA Polymerase Gene from *Thermus aquaticus*. *J. Biol. Chem.*, 246:6427-6437; Landre, P.A., Gelfand, D.H., and Watson, R.M. The Use of Cosolvents to Enhance Amplification by the Polymerase Chain Reaction. In: *PCR Strategies*. Eds. Innis, M.A., Gelfand, D.H., and Sninsky, J.J., (1995). Academic Press, San Diego, CA. pp 3-16; Abramson, R.D. Thermostable DNA Polymerases. In: *PCR Strategies. ibid.* pp 39-57; Abramson, R.A., Thermostable DNA Polymerases: An Update. In: *PCR Applications: Protocols for Functional Genomics*. Eds. Innis, M.A., Gelfand, D.H., and Sninsky, J.J., (1999). Academic Press, San Diego, CA. pp 33-48 and references therein.

7. The rejection appears to be based on a false assumption as to how one of skill would prepare enzymes useful in the claimed methods. To prepare such enzymes, one of skill would not synthesize and test 4 billion enzymes containing each of the species of motif as implied by the assertions at the top of page 6 of the Office Action. Rather, one of skill in the art would determine whether a previously identified thermoactive DNA polymerase comprises the motif defined by SEQ ID NO: 1 using the alignment algorithms noted above. Such sequence comparisons are entirely routine in the art. As demonstrated in the specification, we have identified thermoactive DNA polymerases from 12 different bacterial species that comprise the motif. See Table 1 at page, 12, lines 1-20.

8. After identifying a particular thermostable DNA polymerase that comprises the claimed motif, one of skill would then determine whether the thermostable DNA polymerase enzyme naturally comprises an appropriate residue at position 4 of the motif. If the thermostable DNA polymerase enzyme does not naturally comprise the appropriate residue at position 4 of the critical motif, the ordinarily-skilled artisan can routinely construct such a polymerase using, for

Appl. No. 09/823,649
Amdt. dated April 22, 2004
Reply to Office Action of October 22, 2003

PATENT

example, site directed mutagenesis protocols as described in the specification at page 14, lines 23-27. If the thermostable DNA polymerase enzyme naturally comprises an appropriate residue at position 4 of the critical motif, the ordinarily-skilled artisan will recognize that the thermostable DNA polymerase enzyme is suitable for use in the methods of the present invention without further alteration. Thus, one of ordinary skill in the art can make thermostable DNA polymerases for use in the methods of the invention with no more than routine experimentation.

9. The Examiner is apparently concerned that because amino acid residues comprising the critical motif are not completely conserved among all DNA polymerases, the effect of changes to the amino acid residues other than position 4 would be unpredictable. One of skill would recognize that the lack of complete conservation within the claimed motif in thermoactive DNA polymerases is not critical to practicing the invention. As explained above, thermoactive DNA polymerases are well-characterized. The motifs and domains discussed above provide more than sufficient guidance as to which residues, if any, can be mutated for desired properties in the final enzyme. Moreover, the effect of any particular mutation can be readily tested in routine assays.

10. Moreover, we have prepared and tested two other species of Designer DNA polymerases in addition to the enzymes exemplified in the specification. As can be seen by the results described below, despite variability in positions inside and/or outside the motif identified here, we have shown that reverse transcriptase activity is enhanced by mutation at position 4 of the claimed motif.

11. Using standard techniques as described in the specification we have made and tested three additional DNA polymerases that have enhanced reverse transcriptase activity. Two of these novel Designer DNA Polymerases are ES112 and ES113. ES112 is the E683R mutant form of *Thermus* specie Z05 DNA Polymerase (SEQ ID NO: 11). ES113 is the E683K mutant form of *Thermus* specie Z05 DNA Polymerase (SEQ ID NO: 11). In both of these DNA polymerases the "X" residue at position 4 of SEQ ID NO: 1, or the "E" residue at position 4 in SEQ ID NO: 2 and SEQ ID NO: 3 have been mutated as taught in the specification. The third enzyme, CS6 DNA Polymerase, is a chimeric Designer DNA Polymerase comprising the DNA polymerase domain of *Thermotoga maritima* DNA Polymerase (SEQ ID NO: 15). CS6 DNA

Appl. No. 09/823,649
Amdt. dated April 22, 2004
Reply to Office Action of October 22, 2003

PATENT

Polymerase is more fully described in copending US Patent Application Serial No. 10/401,403, filed March 26, 2003 as SEQ ID NO:107 and in Fig. 5A. In CS6 DNA Polymerase, the "X" residue at position 4 of SEQ ID NO: 1 of the present specification is an arginine (R) and in SEQ ID NO: 5 the 4th residue is also arginine (R). All of these enzymes contain the "Critical Motif" as taught in Table 1 of the specification and all have improved reverse transcription (RT) capabilities.

12. Exhibit 1 ("Improved Mg^{2+} -activated RT-PCR with ES112 & ES113") shows a post-electrophoresis, ethidium bromide-stained and photographed agarose gel of various single enzyme RT-PCR products. The samples on the left were templated with a purified *in vitro* transcript RNA that corresponds to the *gag* region of HIV-1. The samples on the right were "template negative" reactions that did not have any HIV-1 template RNA. The data on the left show that the DNA polymerases ES112 and ES113 were able to generate robust yields of the expected amplicon (PCR product) when activated *either* with Mg^{2+} or Mn^{2+} . In striking contrast, *Thermus* specie Z05 DNA polymerase (the "wild-type control") is *only* able to generate the specific intended PCR product from an RNA template when activated with Mn^{2+} as the metal ion activator. Accordingly, both the ES112 and ES113 mutant DNA polymerases are magnesium-activated thermoactive and thermostable reverse transcriptases as well as possessing manganese-activated thermoactive and thermostable reverse transcriptase activity.

13. Exhibit 2 ("Reduced RT Time Requirement for ES112 & ES113 in Mn^{2+} ") depicts " C_T " values vs. time of reverse transcription ("RT Incubation Time (min)") for three different DNA polymerase/reverse transcriptase enzymes. Reactions were set up and carried out similarly to what was described in Examples 2 and 3 of the specification. That is, real-time or "kinetic" fluorescence measurements were made at every extension cycle and the " C_T " values reflecting the accumulation of a specific amount of double strand DNA PCR product are plotted as a function of the reverse transcription time, which was varied. An increase in RT efficiency at shorter RT extension time results in reaching the threshold value in fewer cycles, *i.e.*, a lower " C_T " value. The data shows that when activated with magnesium ion (" Mg "), mutant Designer DNA polymerases ES112 and ES113 show a similar response to varying reverse transcription time as for *manganese* ion-activated (" Mn ") *Thermus* specie (wild-type) Z05 DNA Polymerase.

Appl. No. 09/823,649
Amdt. dated April 22, 2004
Reply to Office Action of October 22, 2003

PATENT

This supports and extends the data in Exhibit 1 that both the ES112 and ES113 mutant DNA polymerases are magnesium-activated thermoactive and thermostable reverse transcriptases. Furthermore, as taught in the Specification on page 17, lines 19-21, the data in Exhibit 2 also show that when ES112 and ES113 mutant Designer DNA polymerases are activated with manganese ion, they both require much less RT time to achieve a similar low C_T value as *Thermus* specie (wild-type) Z05 DNA Polymerase, as little as 5 min in comparison to 30 min for *Thermus* specie (wild-type) Z05 DNA Polymerase. That is, both ES112 and ES113 mutant Designer DNA polymerases are improved and are much "faster" reverse transcriptases than *Thermus* specie (wild-type) Z05 DNA Polymerase. The improved reverse transcriptase enzymes of the invention could contribute significantly to a shorter time requirement for RT-PCR screening assays to detect important viral pathogens in blood (e.g., not only HIV-1 but also Hepatitis C Virus [HCV], West Nile Virus [WNV], St. Louis Encephalitis Virus [SLV], coronavirus [SARS], etc.).

14. Exhibit 3 ("Efficient RT-PCR at Decreased ES112 & ES113 Enzyme Concentrations") shows the real-time or kinetic fluorescence measurements as a function of PCR cycle number for three different experiments. In Exhibit 3, the upper left panel depicts varying the concentration of *Thermus* specie (wild-type) Z05 DNA Polymerase. The lower left panel depicts varying the concentration of mutant Designer DNA polymerase ES112 and the upper right panel depicts varying the concentration of mutant Designer DNA polymerase ES113. The data clearly show a significantly delayed " C_T " for *Thermus* specie (wild-type) Z05 DNA Polymerase at 2.5 units per reaction (relative to higher concentrations of the enzyme) and in comparison with either ES112 or ES113 at 2.5 units/reaction, two additional Designer DNA Polymerase improved mutant reverse transcriptases of the invention. As taught in the Specification on page 17, lines 25-26, this series of experiments shows that a lower concentration of the improved reverse transcriptases of the invention is sufficient for efficient single enzyme RT and PCR.

15. Exhibit 4 ("Improved Low Copy Sensitivity with ES112 in Mn^{2+} -activated RT-PCR") presents the data from an experiment to support the teaching in the specification on page 16, lines 7-9 ("In Mn^{+2} reactions, the use of the mutant DNA polymerase provides for high

Appl. No. 09/823,649

Amdt. dated April 22, 2004

Reply to Office Action of October 22, 2003

PATENT

temperature reverse-transcription and amplification of RNA with a higher efficiency than achieved using the native enzyme.”). In this experiment, manganese (“ Mn^{2+} ”) activated reactions with wild type *Thermus* specie Z05 DNA polymerase (middle panels) were compared to magnesium (“ Mg^{2+} ”) activated (top panels) or manganese (“ Mn^{2+} ”) activated (bottom panels) reactions with mutant Designer DNA polymerase ES112. For each enzyme, 32-fold replicate *identical reactions* were set-up with on average about 0.5 – 0.7 copies of purified HIV-1 *in vitro* transcript RNA. This is a type of “mini Poisson analysis” in which differences in reverse transcriptase efficiency are readily detected. If cDNA is generated and amplified, RT-PCR assays are “positive.” If cDNA is not efficiently generated, RT-PCR assays are “negative.” This methodology sensitively distinguishes differences in reverse transcription efficiency. We analyzed the 96 PCR products (from each of the three 32-fold replicate RT-PCR assays) by “ T_m ” melting profile, using methods in the specification (page 25, lines 19-25). The T_m of the authentic HIV-1 RT-PCR product under these reaction conditions is about 80°C. In contrast, the T_m of non-specific or unintended side products (at these very-low-to-no target-present reactions) have a significantly lower and readily distinguishable T_m (about 73-77°C). The data in Exhibit 4 clearly show that the improved reverse transcriptases of the invention are characterized by improved reverse transcription efficiency. At these very low starting template concentrations (~ nominal 0.5 template copies/reaction), 10/32 of the wild type manganese-activated *Thermus* specie Z05 DNA polymerase were positive for HIV-1 amplicon (middle panels), identical to the number of positive reactions (10/32) when ES112 DNA polymerase was activated with magnesium (top panels). However, when Designer DNA Polymerase ES112 is activated with manganese (bottom panels), twice as many (20/32) of the HIV-1 RT-PCR assays were positive, indicating a significant increase in RT efficiency (compared to the wild type enzyme) when each is Mn^{2+} -activated. This increase in target detection sensitivity will likely be important in future diagnostic assays not only to monitor successful response to antiviral therapy (e.g., for HIV-1, HCV, etc.) but as importantly for future blood screening assays in further reducing the possibility of an RNA virus-contaminated blood unit finding its way into the blood supply.

16. Exhibit 5 (“RT-PCR Using Mg^{2+} -activated CS6 DNA Polymerase”) shows that CS6, a *Thermotoga maritima*-derived DNA polymerase domain chimeric enzyme with a

Appl. No. 09/823,649
Amdt. dated April 22, 2004
Reply to Office Action of October 22, 2003

PATENT

polymerase domain entirely unrelated to the *Thermus*-derived DNA polymerases described above, is also a magnesium-activated thermostable and thermoactive reverse transcriptase. Exhibit 5 shows a post-electrophoresis, ethidium bromide-stained and photographed agarose gel of several CS6-mediated, single enzyme RT-PCR products. CS6 DNA Polymerase is described in detail in copending US Patent Application Serial No. 10/401,403, filed March 26, 2003 as SEQ ID NO:107 and in Fig. 5A. The "Critical Motif" (Table 1), SEQ ID NO: 1 and SEQ ID NO: 5 of the present specification are found uniquely at CS6 DNA Polymerase amino acids 741 through 751. Note that position 4 of the "Critical Motif" (Table 1) in CS6 DNA Polymerase is not glutamic acid (E) and is arginine (R). For the experiment in Exhibit 5, purified, *in vitro*-transcribed AW109 cRNA was used at different input copy numbers (10^6 , 10^5 , 10^4 , 10^3 , or none) in duplicate reactions with CS6 DNA Polymerase and magnesium ("Mg²⁺") activation. The results clearly demonstrate that thermophilic and thermostable Designer DNA Polymerase CS6 is an improved, magnesium-activated reverse transcriptase. Furthermore, the "Critical Motif" (Table 1 in the specification) shows that the majority of the amino acids (6 of the 11 positions) are different between many of the *Thermus* genus enzymes and the *Thermotoga* genus enzymes. Nevertheless, when the teachings of the specification are followed, improved reverse transcriptases are obtained. Finally, there is a great deal of amino acid sequence divergence between the *Thermus* genus DNA polymerases and the *Thermotoga* genus DNA polymerases, reflecting the considerable evolutionary divergence of the microorganisms from which the

enzymes originally derive. Indeed, there is only about 45% overall amino acid identity between aligned DNA polymerase sequences from representatives of the *Thermus* genus and representatives of the *Thermotoga* genus. That is, more than half of the amino acids are different. However, SEQ ID NO:1 and the "Critical Motif" (Table 1) of the invention can readily be uniquely identified in the DNA polymerase domains of these microorganisms' DNA polymerases.

17. I further declare that all statements made herein of my knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both (18 U.S.C. § 1001), and may jeopardize the validity of the patent application or any patent issuing thereon.

Date: April 21, 2004

By: David H. Gelfand

David H. Gelfand, PhD.

60159838 v1